

1625
Bhw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Hiroharu MATSUOKA et al

Appln. No. 09/890,219

Date Filed: December 12, 2001

For: SUBSTITUTED PHENETHYLAMINE DERIVATIVES



Art Unit: 1625

Examiner: B.M. Robinson

Washington, D.C.

Atty.'s Docket: MATSUOKA=18

Date: August 5, 2004

Confirmation No. 7465

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Amendment
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

Transmitted herewith is a [X] REPLY TO ELECTION/RESTRICTION OFFICE ACTION in the above-identified application.

- [] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted
- [] Applicant claims small entity status. See 37 C.F.R. §1.27.
- [] No fee is required.

The fee has been calculated as shown below:

	(Col. 1) CLAIMS REMAINING AFTER AMENDMENT	(Col. 2) MINUS	(Col. 3) HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*		** 20	0
INDEP.	*		*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY		OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE	RATE	ADDITIONAL FEE
x 9	\$	x 18	\$
x 43	\$	x 86	\$
+ 145	\$	+ 290	\$
ADDITIONAL FEE TOTAL		TOTAL	

OR

OR

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
- *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 55.00
- [] Second - \$ 210.00
- [] Third - \$ 475.00
- [] Fourth - \$ 740.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- [XX] First - \$ 110.00
- [] Second - \$ 420.00
- [] Third - \$ 950.00
- [] Fourth - \$ 1480.00

Month After Time Period Set

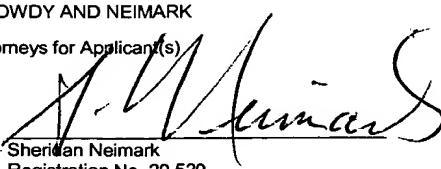
Less fees (\$_____) already paid for ____ month(s) extension of time on _____.

Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$110.00

The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By: 
Sheridan Neimark
Registration No. 20,520

Facsimile: (202) 737-3528
Telephone: (202) 628-5197



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: MATSUOKA=18

In re Application of:) Art Unit: 1625
Hiroharu MATSUOKA et al) Examiner: B. M. Robinson
Appln. No.: 09/890,219) Washington, D.C.
Filed: December 12, 2001) Confirmation No. 7465
For: SUBSTITUTED PHENETHYLAMINE) August 5, 2004
DERIVATIVES)

REPLY TO ELECTION/RESTRICTION OFFICE ACTION

Customer Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

Applicants acknowledge receipt of the Office Action mailed June 18, 2004, entirely in the nature of restriction or election requirements. Filed herewith is a petition for one month's extension of time and payment of the one month's late fee.

Acknowledgement by the PTO of the receipt of applicants' papers under Section 119 would be appreciated.

Restriction has been required allegedly under PCT Rule 13.1 among what the examiner deems to be eleven (11)

patentably distinct inventions. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, with traverse and without prejudice.

The requirement is respectfully traversed on the basis that it does not comply with the requirements of PCT Rules 13.1 and 13.2. The PTO has not demonstrated the absence of "a technical relationship among those inventions involving one or more of the same or corresponding technical features" as required by PCT Rule 13.2. With the possible exception of any claims directed to intermediates, the subject matter of applicants' claim 1 extends through all the groups and is the common special technical feature. Reliance on MPEP 806.04, MPEP 808.01 and certain case law cited in the Official Action is misplaced, as such case law and such portions of the MPEP relate to standard U.S. restriction practice, not "unity of invention" practice as is required in the present application which is the U.S. national phase of an international PCT application.

With respect, as the requirement is improper, not justified by the law or the solemn treaty obligations of the United States, and is moreover unfair, applicants respectfully request that the requirement be withdrawn and that all of applicants' claims be examined on the merits.

In addition to the aforementioned restriction requirement, the examiner has also required applicants to elect a "single disclosed species". Again, even though the applicants traverse the requirement, they are required to make an election, and therefore applicants' hereby respectfully and provisionally elect the compound of Example 102, e.g. page 264, with traverse and without prejudice.

Again, the requirement is in violation of PCT Rules 13.1 and 13.2. Therefore, there is no legal basis for the requirement.

Applicants respectfully point out that the present application has undergone an international preliminary examination, and the international preliminary examination report (IPER) indicates that only original PCT claims 30-34, reciting intermediates of the compound set forth in claim 1, do not share all the same technical features, and thus are not so linked as to form a single general inventive concept with the remaining claims. While applicants understand that the present examiner is not required to adhere to the findings of the earlier examiner, the fact of the matter is that the earlier examiner properly followed the PCT rules, whereby there should be no restriction or species requirement beyond what was required during the international stage.

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Reply dated August 5, 2004
Reply to Office Action of June 18, 2004

Again in this regard, the PTO is obligated to follow the solemn treaty obligations of the United States, not abrogate them, and moreover should be guided by principles of harmonization and comity.

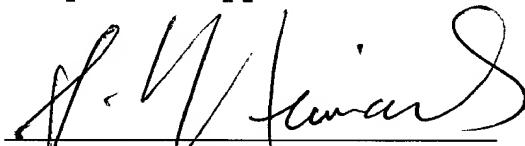
Applicants accordingly also request withdrawal of the election of species requirement, and examination of all the species on the merits.

Applicants respectfully request favorable reconsideration, and respectfully await the results of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By


Sheridan Neimark
Registration No. 20,520

SN:jec:lms
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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